

Notice of Non-Responsive Amendment

1. The amendment filed September 18, 2008, is non-responsive for the following reasons:

The amendment filed September 18, 2008, would amend all claims, which were previously drawn to the elected invention, so as to present only claims drawn to a non-elected invention.

The claims, as would be amended, are not readable on the elected invention for the following reasons:

In this case, the response filed November 9, 2007, at page 14, indicates that the amino acid sequence of SEQ ID NO:22 has been changed from the originally filed and examined amino acid sequence of SEQ ID NO:22¹.

Accordingly, by changing the amino acid sequence of SEQ ID NO:22, it is apparent the claims, as would be amended, which are drawn to a polypeptide consisting of the amino acid sequence of SEQ ID NO:22, are drawn to a protein with differs in amino acid sequence from the originally claimed and examined protein. Notably, while the amended polypeptide consisting of the amino acid sequence of SEQ ID NO:22 may be highly similar to the originally presented sequence of SEQ ID NO:22, it is nonetheless noted that changing the amino acid sequence of SEQ ID NO:22 results in a structurally and functionally different polypeptide which was not required by the originally elected and examined polypeptide. Thus, as would be amended, the claims are drawn to a patentably distinct product when compared to the elected invention.

Secondly, the Examiner recognizes that, according to M.P.E.P § 803, there are two separate requirements that must be met to establish the propriety of the restriction

¹ While the Examiner further acknowledges that the response states the discrepancy in sequence was noted by the Examiner, in this case, the Examiner merely objected to the specification as not being in sequence compliance at pages 6 and 7 in the previous Office action, noting that the amino acid sequence in figure 4 was different than the amino acid sequence of the originally filed SEQ ID NO:22. The sequence set forth in Figure 4, which was not originally identified by SEQ ID NO:, was not searched or considered in the previous office action.

between any two inventions. Having shown that the claims, as would be amended, are drawn to an invention patentably distinct from the elected invention, it is now necessary to provide reasons that there would be a serious burden on the examiner, to search and consider the claims as would be amended.

Notably, a serious search and examination burden exists if one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

In this case, there would be a serious search and consideration burden to consider the claims, as would be amended. Notably, because of the change in amino acid sequence, the examination of the amended claims would require new and different considerations and searches, which were not before necessary. For example, perhaps first and foremost, it is aptly noted that because the amino acid sequence of the polypeptide has been changed, a new sequence search of the amended sequence, which was not before required, would now be necessary in up to 10 different databases. This would create an undue burden on the Patent and Trademark Office due to the complex nature of the search in terms of computer time needed to perform the search and the subsequent analysis of the search results by the Examiner.

Accordingly, for these reasons, there would be a serious search and consideration burden to consider the claims, as would be amended.

Thus, if claims drawn to a polypeptide with the different amino acid sequence, as would be amended, had been originally presented, they would have been properly restricted from the elected invention as such a polypeptide has been shown to be patentably distinct from the originally elected and examined invention and because the examination of the claims, as would be amended, could not be made without serious burden. See MPEP § 803.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, after entry of the amendment filed September 18, 2008, all remaining claims would be withdrawn from consideration as being directed to a non-elected invention, and therefore these amendments, which present only claims drawn to such non-elected inventions, are non-responsive and will not be entered. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Since the above-mentioned reply appears to be bona fide, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brad Duffy whose telephone number is (571) 272-9935. The examiner can normally be reached on Monday through Friday 7:00 AM to 4:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully,
Brad Duffy
Examiner, Art Unit 1643
571-272-9935

/Stephen L. Rawlings/
Primary Examiner, Art Unit 1643

/bd/
Examiner, Art Unit 1643
January 12, 2009